

REMARKS

This Amendment is submitted in response to the Office Action mailed October 5, 2006. Claims 1-8, 13, and 14 remain pending in the Application and stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse these rejections and assert that claims 1, 13, and 14 set forth in the amendment filed June 9, 2006, are supported by the drawings of the Application as-filed.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., Moba, B.V. v. Diamond Automation, Inc., 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d at 1116 (Fed. Cir. 1991); MPEP §2163(I). "It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." MPEP §2163(I). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)(underlining added). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete. See, e.g., Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d

1641, 1647 (1998); Amgen, Inc. v. Chugai Pharmaceutical, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991).

If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), . . . the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976); MPEP §§2163(II)(A), 2163.04. To evaluate whether the disclosure supports the claimed invention, "the examiner should review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention." MPEP §2163(II)(A)(2).

In the Amendment filed June 9, 2006, claim 1 was amended to recite that the flexible skin has "a uniform thickness extending across said apertures in said target area." Applicants further pointed out that support for this amendment could be found in the originally-filed Application with reference to paragraph 0019 and FIGS. 1, 2, and 2A. Specifically, FIGS. 1, 2, and 2A clearly depict skin layer 22 having a uniform thickness in this area. The Detailed Description of the Application has been further amended herein to explicitly recite that skin layer 22 has a uniform thickness at least in the target area. This amendment does not add new matter. See, MPEP §2163.06 ([I]nformation contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter). The Examiner has failed to present evidence or reasoning that explains why persons skilled in the art would not recognize in the figures that the skin layer has a uniform thickness

as set forth in claim 1. For at least these reasons, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claims 2-8 each depend from independent claim 1, and are therefore in condition for allowance for at least the reasons discussed above with respect to claim 1. Accordingly, Applicants respectfully request that the rejections of claims 2-8 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claim 14 was added by the Amendment filed June 9, 2006. As discussed in the June 9 Amendment, claim 14 is similar to claim 1 but recites that the substrate has a first thickness, and the flexible skin has "a second thickness less than said first thickness." Applicants also noted that support for new claim 14 could be found in the Application as-filed, with reference to the drawings. Specifically, FIGS. 2 and 2A show skin layer 22 having a thickness that is less than the thickness of the substrate member 20. In rejecting claim 14 under 35 U.S.C. §112, first paragraph, the Examiner again failed to explain why persons skilled in the art would not recognize that the skin layer has a thickness that is less than the thickness of the substrate member, as required by MPEP §2163.04, discussed above. For at least these reasons, the Office Action fails to set forth a proper *prima facie* case that supports the rejection. Applicants therefore respectfully request that the rejection of claim 14 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claim 13 was also added in the Amendment filed June 9, 2006. As discussed therein, claim 13 is similar to claim 1, but recites that the flexible skin has an outer surface and is "devoid of apertures between said substrate member and said outer surface." In rejecting claim 13, the Examiner noted that the recitation "devoid of

apertures between said substrate member and said outer surface," is a negative limitation. The Examiner cited MPEP §2173.05(i) for the proposition that the recited limitation could not be supported by the originally filed drawings. However, MPEP §2173.05(i) further states:

Note that a lack of literal basis in the Specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP §2163-2163.07(b) for a discussion of the written description requirement of 35 U.S.C. §112, first paragraph.

MPEP §2173.05(i) therefore is not an absolute prohibition against amending claims to include a negative limitation based upon, for example, the originally-filed figures of an application. Rather, the analysis of whether the originally-filed disclosure supports an amendment to add a negative limitation is guided by MPEP §2163, which requires that the Examiner consider the originally-filed drawings and provide evidence explaining why persons skilled in the art would not have recognized that the skin layer 22 was devoid of apertures between the substrate member and the outer surface, as discussed above. FIGS. 1, 2, and 2A clearly show that skin layer 22 has no such apertures.

In Ex parte Parks, cited in MPEP § 2173.05(i), a negative limitation in the claims was held to be supported by the Specification, even though the Specification provided no literal support for the limitation, because it was determined that persons skilled in the art would have recognized that the claimed invention included the limitation. Similar to the invention in Parks, persons skilled in the art would have understood that the flexible skin layer recited in claim 13 is "devoid of apertures between said substrate member

and said outer surface," with reference to the originally filed drawings which clearly illustrate skin layer 22 without such apertures. Accordingly, Applicants assert that claim 13 is supported by the Specification as-filed and respectfully request that the rejection of claim 13 under 35 U.S.C. §112, first paragraph, be withdrawn.

Conclusion

In view of the foregoing amendments to the specification and the remarks set forth herein, Applicants respectfully believe this case is in condition for allowance and respectfully request allowance of the pending claims. If the Examiner believes any matter requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicants are of the opinion that no fee is due as a result of this communication. However, if any such fee is due, please apply such fees or credits necessary to complete this communication to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: /David W. Dorton/
David W. Dorton, Reg. No. 51,625

2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202
(513) 241-2324 (voice)
(513) 241-6234 (facsimile)